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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,856	07/14/2003	Kyoji Saito	P23956	3802

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

VU, THONG H

ART UNIT PAPER NUMBER

2142

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,856

Applicant(s)

SAITO ET AL.

Examiner

Thong H Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2142

1. Claims 1-8 are pending.

Priority

2. This application is a Continuation of 09/099528 (USP 6,618,749) filed 6/18/98.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are rejected under the judicially created doctrine of double patenting over claims 1-9 of U. S. Patent No. 6,618,749 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

(**749**) 1. An Internet transmission apparatus connected to a computer network, comprising:
a transmitter that transmits a message in e-mail format to a designated destination via the computer network;
a receiver that receives e-mail data transmitted via the computer network;
a determiner that determines whether or not the received e-mail data is an error message indicating that the e-mail data transmitted from said transmitter has not been successfully transmitted;
an extractor that, when said determiner determines that the received e-mail is the error message, extracts a specific data from the received e-mail data, the specific data containing at least information regarding an error and a predetermined portion of the transmitted message from said transmitter;
an editor that edits the extracted specific data so that the specific data fits on one page of recording paper having a predetermined size, the editor not changing a resolution of the specific data, and a printer that prints the edited specific data on one page of recording paper having the predetermined size, said editor being configured to edit the specific data when the transmitted message and at least the information regarding an error cannot fit on the one page of recording paper such that another portion of the transmitted message is not printed.

(**Application**) 1. An Internet facsimile apparatus for receiving e-mail data and connected to a computer network, the Internet facsimile apparatus comprising:
an e-mail receiver that receives e-mail data transmitted via the computer network, the e-mail data including a header, document information and image information;
a determiner that determines whether or not the document information contains predetermined data indicating that the e-mail data was transmitted from an Internet facsimile apparatus; and
a printer that prints the entire received e-mail data when said determiner determines that the document information does not contain the predetermined data, and that prints only the image information when said determiner determines that the document information contains the predetermined data.

It was clearly that an editor (or printer) determines the electronic message whether or not contains the TIFF header (as a specific data) to produce the image (the specific data in a predetermined size) and the printer can not print the TIFF image if an error was found on the transmitted message (the paper size is not fit. It was well-known that the TIFF support paper size, see RFC 2306).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishibashi et al (Ishibashi 6,374,291 B1).

5. As per claim 1, Ishibashi discloses an Internet facsimile apparatus for receiving e-mail data and connected to a computer network the Internet facsimile apparatus comprising:

an email receiver that receives email [Ishibashi, Email, Internet, TIFF and facsimile, col 4 line 10-col 5 line 26];

data transmitted via the computer network, the e-mail data including a header, document information and image information [Ishibashi, Email and header, col 4 line 10-col 5 line 26];

a determiner that determines whether or not the document information contains predetermined data (i.e.: TIFF) indicating that the e-mail data was transmitted from an Internet facsimile apparatus [Ishibashi, Image data is changed to Email format, col 6 line 60-col 7 line 10]; and

a printer that prints the entire received e-mail data which said determiner determines that the document information does not contain the predetermined data [Ishibashi, a printer, col 3 lines 34-39] and that prints only the image information when said determiner determines that the document information contains the predetermined data. It was clearly that the printer only print the predetermined data (TIFF) by the determination of the TIFF header.

6. Claim 5 contains the similar limitations as the apparatus claim 5. Therefore claim 5 is rejected by the same rational set forth claim 5.

7. As per claim 2,4 and 6,8 Ishibashi discloses content of the predetermined data is "this mail is accompanied by TIFF-format image data" [Ishibashi, the Email header information to the TIFF image data converted to text data, the attachment of predetermined header information to email of the internet is regulated, col 1-7].

8. As per claim 3 and 7, Ishibashi discloses a document information determiner that determines whether or not the document information is contained in the e-mail data received by said e-mail receiver, wherein said printer prints only the image information

Art Unit: 2142

when said document information determiner determines that the document information is not contained in the email data [Ishibashi, the email header and TIFF image data help to determine whether the email contains the TIFF image, col 4 lines 45 et seq].

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (571) 272-3896. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Patent Examiner
Art Unit 2142

A handwritten signature in black ink, appearing to read 'Thong Vu', with a horizontal line underneath.